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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/530,563	04/07/2005	Takao Hasegawa	040894-7216	8997
9629 7590 12/20/2007 MORGAN LEWIS & BOCKIUS LLP 1111 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20004			EXAMINER REYNOLDS, STEVEN ALAN	
			ART UNIT 3728	PAPER NUMBER
			MAIL DATE 12/20/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/530,563

**Applicant(s)**

HASEGAWA ET AL.

**Examiner**

Steven Reynolds

**Art Unit**

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 10-12 and 14-30 is/are pending in the application.
- 4a) Of the above claim(s) 22-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-12, 14-21 and 28-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. This office action is in response to the reply filed on 11/30/2007, wherein claims 10 and 18 were amended. Claims 10-12, 14-30 are pending. Claims 22-27 remain withdrawn from consideration.

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#### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

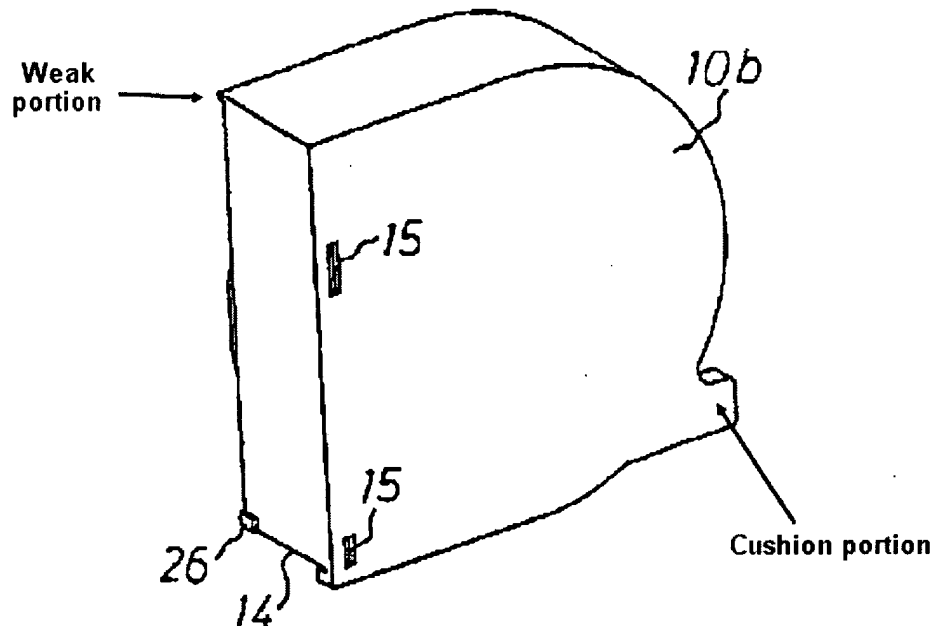
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 10-12, 14-19 and 28-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Straat (US 5,794,833). Straat discloses a staple case (10) that contains a roll staple (9) formed by connecting unformed staples in a roll shape comprising: an opening (29), formed at a part of the staple case, and through which a member for rotating the roll staple is capable of being brought into contact with a circumferential surface of the roll staple, wherein a direction from a center of the roll staple to the opening and a tangent line of a portion of the roll staple where the member is brought into contact with the circumferential surface of the roll staple are substantially orthogonal.

Regarding the intended use of the claimed invention "an opening....through which a member for rotating the roll staple is brought into contact with a circumferential

surface the roll staple", it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. If the prior art structure is capable of performing the intended use, then it meets the claim. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Regarding claims 11, 12 and 14-17, Straat discloses a pull-out opening (14) through which the roll staple is pulled out; the pull-out opening is provided at a vertical center of a front face of the staple case (since no reference point for the orientation of the case is claimed, the case of Straat can be oriented in a position where the pull-out opening is at a vertical center of a front face); a cushion portion (See figure below); a portion (side wall) for positioning in a containing chamber; a guide portion (front wall) for guiding the staple case to a containing chamber; a first case half (10a); and a second case half (10b).



Regarding claims 18-19 and 28-30, Straat discloses a first opening through which the roll staple is pulled out; and a second opening synonymous with the opening through which a member for rotating the roll staple is brought into contact with the roll staple, wherein the first opening is provided on the second case half, and the second opening is provided on the first case half; a weak portion (See figure above) on a joint between the first case half and second case half; the staple case is attachable to and detachable from an electric stapler; the staple case is attachable to and detachable from a staple cartridge that is attachable to and detachable from an electric stapler; and a staple pull-out opening; wherein the direction from the center of the roll staple to the staple pull-out opening and a direction in which the roll staple is fed out from the pull-out opening are substantially orthogonal.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Straat (US 5,794,833) in view of Haramiishi (US 7,048,165). Straat discloses an upper/front face (10a) and a bottom/back face (10b) having a different shape to the upper face (10a and 10b have different "weak portions" as seen in figure above). Straat discloses all the limitations of the claims except for the specifics of the markings on the staple case.

However, Haramiishi teaches a cartridge casing (24) comprising an arrow on the side face of the case for the purpose of indicating the direction in which the case is inserted into the stapler (See Fig. 7 embodiment). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the staple case of Straat with the arrow marking on the side face as taught by

Haramiishi in order to show the user the correct direction in which the staple case is to be inserted into the stapler.

***Response to Arguments***

7. Applicant's arguments with respect to claims 10-12 and 14-21 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Reynolds whose telephone number is (571) 272-9959. The examiner can normally be reached on Monday-Friday 9:00am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571)272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SR

12/17/07

  
Jila M. Mohandes  
Primary Examiner